

REMARKS

In light of the following remarks and foregoing amendments, applicant respectfully submits that the above-identified application is in condition for allowance. Consideration and allowance of claims 7-21 is hereby respectfully solicited.

In the pending action, claim 2 and 6 have been rejected as indefinite under 35 U.S.C §112. Claims 1-3, 5, and 6 have been rejected under 35 U.S.C. §103(a) as obvious over Ashby et al (U.S. Patent No. 4,396,511) in view of Bartelheim (U.S. Patent No. 2,441,181.)

Applicant respectfully submits that in light of the cancellation of claims 1-3, 5 and 6, and the subsequent additional of claims 7-21, the pending rejections are moot.

I. INDEPENDENT CLAIMS 7 AND 17

Independent claims 7 and 17 recite, *inter alia*, a method for producing an oblong rim hole including bending a single layer rim to form a flange, or forming an oblong rim into a single layer flange, engageable with a bottom surface of the second workpiece. None of the cited reference suggests or disclose, at any level, forming a single layer flange or rim, much less one having an oblong shape.

Ashby et al. does not suggest or disclose forming a single layer flange or rim of any kind, much less a single layer flange or rim having an oblong shape. The rim hole of Ashby et al. is formed from a pair of layers cooperatively curled into an integral fastener. In particular, a curl die strokes upwards to engage the pair of layers and form two co-axial metal cylinders rolled between a concave curl die face and an anvil. Ashby et al. does not suggest or disclose forming a single layer flange or rim of any kind, much less a single layer flange or rim having an oblong shape.

Bartelheim does not suggest or disclose forming a flange of any kind, much less a single layer flange, a flange having an oblong shape or a flange engageable with a bottom surface of a second workpiece.

Bartelheim simply discloses an eyelet formed within a stack of at least

two workpieces. In particular, the eyelets of Bartelheim engage the interior surface of a hole formed through the two workpieces, but the eyelets do not extend to form a rim or flange of any kind, much less a single layer flange, a flange having an oblong shape or a flange engageable with a bottom surface of a second workpiece.

Because neither Ashby et al. nor Bartelheim contain each and every element recited in independent claims 7 and 17, either expressly or inherently, they cannot anticipate these claims. See *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). In particular, neither reference suggest or disclose bending a single layer rim to form a flange, or forming an oblong rim into a single layer flange, engageable with a bottom surface of the second workpiece, much less one having an oblong shape.

Furthermore, because neither Ashby et al. nor Bartelheim teach or suggest all of the claim limitations set forth in the claims at issue they cannot be the basis for a *prima facie* case of obviousness¹. As discussed above, neither reference suggest or disclose bending a single layer rim to form a flange, or forming an oblong rim into a single layer flange, engageable with a bottom surface of the second workpiece, much less one having an oblong shape. As a result, none of the references taken alone or in combination derive the benefits of a low profile rim hole or a rim hole resistant to rotation as realized by the claims at issue. For these reasons, independent claims 7 and 17 cannot be rendered obvious in light of Ashby et al., either alone or in combination with Bartelheim.

¹ To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.

II. INDEPENDENT CLAIM 12

Independent claim 12 recites, *inter alia*, a method for producing an rim hole including forming a flange from a single planar workpiece to engage a bottom surface of the plurality of planar workpieces. None of the cited reference suggests or disclose, at any level, forming a single layer flange or rim.

As discussed above in Section I, Ashby et al. does not suggest or disclose, at any level, forming a flange from a single planar workpiece. The rim hole of Ashby et al. is formed from a pair of layers cooperating to form two co-axial metal cylinders rolled between a concave curl die face and an anvil. Ashby et al. does not suggest or disclose forming a flange from a single planar workpiece.

Bartelheim does not suggest or disclose forming a flange of any kind, much less a single layer flange. Bartelheim simply discloses an eyelet formed to engage the interior surface of the hole, the eyelet does not extend to form a rim or flange of any kind.

Because neither Ashby et al. nor Bartelheim contain each and every element recited in independent claim 12, either expressly or inherently, they cannot anticipate this claim. See *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Furthermore, because neither Ashby et al. nor Bartelheim teach or suggest all of the claim limitations set forth in the claim at issue they cannot be the basis for a *prima facie* case of obviousness¹. As discussed above, the references do not suggest or disclose forming a flange from a single planar workpiece. As a result, the references, taken alone or in combination, do not derive the benefit of a low profile rim hole as realized by the claims at issue. For these reasons, independent claim 12 cannot be rendered obvious in light of Ashby et al., either alone or in combination with Bartelheim.

III. CONCLUSION

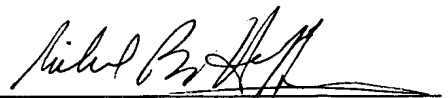
For these foregoing reasons, applicant submits that the application is in condition for allowance. If there are any additional fees or refunds, the Commissioner is hereby directed to charge or debit Deposit Account No. 13-2855. Withdrawal of the rejections, and consideration and allowance of claims 7-21 is therefore respectfully requested.

Respectfully submitted for,

MARSHALL, GERSTEIN & BORUN

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By:


Richard B. Hoffman
Reg. No. 26,910
6300 Sears Tower
233 South Wacker Drive
Chicago, Illinois 60606-6402
(312) 474-6300